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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,899	06/24/2003	Robert C. Hightower	9066-28	2187
20792	7590	02/24/2006	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			TRAN, HANH VAN	
PO BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	
			3637	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/602,899	Applicant(s) HIGHTOWER, ROBERT C.	
	Examiner Hanh V. Tran	Art Unit 3637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the Final Office Action from the examiner in charge of this application in response to applicant's amendment dated 12/14/2005.

Drawings

2. The drawings were received on 12/14/2005. These drawings are acceptable.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each of the independent claims, the term "and/or" is indefinite for failing to clearly define the metes and bounds of the claimed invention. Claim 27, since claim 16 recited that the inner and outer wall are substantially parallel, the limitation in claim 27 of the inner and outer walls being angled with each other renders the claimed indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7, 9-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,368,694 to Marsh et al.

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Marsh et al discloses a plastic corner protector comprising all the elements recited in the above listed claims including, such as shown in Fig 1, a top member 23, an inner wall 40, an outer wall 31, a side wall 41, ribs 62, wherein a portion of the inner wall 40 adjacent the side wall is recessed to form an opening into a cavity defined by the inner wall, the outer wall and the side wall 41.

7. Claims 1, 6, 16-18, 22-23 stand rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,947,037 to Hornberger et al.

Hornberger et al discloses a plastic corner protector 80 comprising all the elements recited in the above listed claims including, such as shown in Figs 2, 7 and 12, an outer wall, an inner wall 82 extending substantially parallel to the outer wall, a side wall 86,88, a top wall 140; wherein the side wall and the outer wall connect to form an acute angle of approximately 67 degrees, while the side wall and the inner wall connect to form an obtuse angle (see attached marked-up copy), wherein a portion of the inner wall adjacent the side wall is recessed to form an opening into a cavity defined by the inner wall, the outer wall and the side wall.

8. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,305,599 to Tsubaki et al.

Tsubaki et al discloses a cabinet comprising an enclosure having a plurality of walls with a plurality of corners, a protective cover 3, such as shown in Fig 1B, comprising an outer wall 22, an inner wall 22 located opposite the outer wall and extending substantially parallel to the outer wall, a side wall 23 connected the outer wall

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to the inner wall, a top member disposed between and connected to at least one of the outer wall, the inner wall and the side wall.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 16, 18-19, and 25-27 stand rejected under 35 U.S.C. 102(e) as being anticipated by USP 6,516,730 to Mason.

Mason discloses a plastic cover protector comprising all the elements recited in the above listed claims including, such as shown in Figs 2-3, a top member 116C, an inner wall 116B, an outer wall 116A located opposite the inner wall 116A and extending substantially parallel to the inner wall 116A, a side wall 118A, indicia (Fig 2), wherein a portion of the inner wall adjacent the side wall is recessed to form an opening into a cavity defined by the inner wall, the outer wall and the side wall.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al in view of Mason.

Marsh et al discloses all the elements as discussed above except for an indicia thereon.

Mason discloses a protective cover having an indicia provided thereon for advertisement or aesthetic purpose. Therefore, it would have been obvious to modify the structure of Marsh et al by providing an indicia thereon for advertisement or aesthetic purpose, as taught by Mason, since both teach alternate conventional protective cover structure, used for the same intended purpose, thereby providing structure as claimed.

14. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason in view of Marsh.

Mason discloses all the elements as discussed above except for a plurality of support ribs are provided on the top surface of the top member that connect the outer wall to the inner wall, at least one rib connects the outer wall to the side wall.

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Marsh teaches that it is well known in the art to provide a corner protector with a plurality of ribs 62 for connecting the outer wall to the inner wall, as well as the outer wall to the side wall in order to increase the rigidity of the corner protector. Therefore, it would have been obvious to modify the structure of Mason by providing a plurality of ribs 62 for connecting the outer wall to the inner wall, as well as the outer wall to the side wall in order to increase the rigidity of the corner protector, as taught by Marsh, since both teach alternate conventional corner protector structure, used for the same intended purpose of protecting the corner of an article, thereby providing structure as claimed.

Allowable Subject Matter

15. Claims 29-30 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

16. Applicant's arguments filed 12/14/2005 have been fully considered but they are not persuasive. In response to applicant's argument on page 10 that the inner wall of Marsh is not "recessed", the examiner takes the position that the term recessed fails to provide adequate structural limitation in order to distinguish from the prior art of record. It should be something along the line of the inner wall having a cutout portion.

17. Applicant's arguments with respect to Marsh regarding the 90 degrees angle have been considered but are moot in view of the new ground(s) of rejection.

18. In response to applicant's argument on page 10 regarding Hornberger fails to disclose the acute and obtuse angles, please see attached marked-up copy for the examiner's interpretation of the acute and obtuse angles of Hornberger.

19. In response to applicant's argument on page 11 Hornberger does not include any recess, the examiner takes the position that the term recessed fails to provide adequate structural limitation in order to distinguish from the prior art of record.

20. In response to applicant's argument regarding "for protecting a second outside edge of the object", the examiner takes the position that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

21. Applicant's arguments with respect to the rejection of claims 1-3, 7-15 based on Mason have been considered but are moot in view of the new ground(s) of rejection.

22. In response to applicant's argument on page 13 that the side wall of Mason does not connect the outer wall to the inner wall, the examiner takes the position that the upper portion of the side wall does indeed connect the outer wall to the inner wall, such as shown in Fig 2.

23. In response to applicant's argument that Mason and Marsh is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the

claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both are drawn to corner protectors.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hightower, Kempkes, Dionne, and Kelly et al all show structures similar to various elements of applicant's disclosure.

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HVT *HVT*
February 20, 2006

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

A handwritten signature in black ink, appearing to read "Lanna Mai", with a long horizontal flourish extending to the right.

